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10/521,555	01/19/2005	Pierre Doublet	052014	9342
38834	7590	02/23/2010	EXAMINER	
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP			DICUS, TAMRA	
1250 CONNECTICUT AVENUE, NW				
SUITE 700			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20036			1794	
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			02/23/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/521,555	DOUBLET, PIERRE	
	<b>Examiner</b>	<b>Art Unit</b>	
	TAMRA L. DICUS	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12 January 2010.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-3,5-7,11,12,15,16 and 22-27 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-3,5-7,11,12,15,16 and 22-27 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Request for Continued Examination*

The RCE is acknowledged.

The prior rejections are overcome by applicant's amendment and withdrawn.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1-3, 5-8, 11-12, 15-17, and 22-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of 1-3 and 11-12 copending Application No. 10/541,202.**

Although the conflicting claims are not identical, they are not patentable distinct from each other because the present claims differ only in the recitation of a more broad invention. Thus the present claims are broader in scope and encompasses that which is claimed '202 application. This is a provisional obviousness-type double patenting rejection.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 15, 16, 25 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Because claim 8 is cancelled, claims 15 and 16 are indefinite (along with claims 25 and 27).

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-3, 5-7, 11-12, 15-16, and 22-27 are rejected under 35 U.S.C. 103(a) as unpatentable over US 6,991,260 to Fan et al. in view of US 6,471,248 B2 to Hardwick et al.**

Fan teaches a two-sided paper with two sets of indicia (see 16, 22 patterned lines FIG. 2, in perfect registration with each other, superimposed on each side of a document, includes paper, wherein the set of lines on the front and back or reverse side can be seen in either light dependent upon the view of the observer, if viewing the front side having the printed indicia, the observer sees through the document to the second reverse side of indicia wherein the second reverse side indicia is observed. See Figs. 3-9 showing the variety of ways the combined sets of complementary lines arranged to form a complete image. See col. 3, 4:30-68. The lines are a variety of frequencies and colors including black ink-see 3:50-68 (re claim 2-3, 5-7, 11, 15, 17, 28-31). The set of lines also form a combined image that if misaligned, cannot be seen (Fig. 9, 4:55-68), equivalent to "whereas the 3D effect would not be present if the first and second set of lines weren't in accurate registration"). The lines also have shades of gray (claims 11 and 15, see 3:1-20) using halftoning. The lines such as geometric shapes, graphic illustrations, alphanumeric characters and other curvilinear patterns are also taught (claim 2).

Because black inks, metallics (conductive) inks are used by Fan, the properties of claims 22-27 are inherently expected to react under the claimed sources of light and radiation not mentioned by Fan, (see Applicant's specification on page 4, lines 12-20

only mentioning black or gray color lines reacting under different sources of radiation). Because the same lines and positioning and colors are employed teaching viewing angles, resolution, straight and curved lines, and lightness to darkness effects, Fan's teaching embraces a 3D volume effect per claim 1 and varying printing intensity and density of claim 2. Thus Fan teaches the placement of lines that form an image with a 3D effect.

Should the inks not function inherently as claimed, Hardwick is used to show black ink performs in this function as set forth hereafter. Fan, while teaching the use of black inks (opacifying ink) in line patterns and images viewed in transmitted or reflected light, does not explicitly state the first and second set of lines are visible in transmitted but not in reflected when viewed from the respective sides as claimed.

Hardwick, analogously directed to accurately registered images, teaches using opacifying inks on both sides of a security document, viewed from both sides A and B, printed in images comprising lines, wherein the opacifying ink obscures the image from the alternative side viewpoint but seen in transmitted light (see at least 2:10-30, 2:45-65, and 4:45-68 "the security device has a different appearance when viewed from opposite sides of the document. For instance, the security device may be clearly visible in the half-window from the side of the second surface of the substrate, but not visible or only partially visible, e.g. only in transmission from the side of the first surface of the substrate. Preferably, the security device is more visible in transmitted light than in reflected light from the side of the first surface of the substrate. ...part of the security

device which extends outside the area of the half-window is more visible in transmitted light than in reflected light. When a security device is provided in a banknote or security document in this manner, different parts of the security device may present different effects to a viewer from each side of the banknote or security document. For instance, if the layer or layers of opacifying ink only partially obscure the security device, the part of the security device outside the half-window area may be visible, at least in transmission, but not as apparent as the part of the security device within the area of the half-window. It is therefore possible for different contrasting effects to be observed between relative visibilities of the different parts of the substrate from both sides of the security document.) See further Fig. 6 and associated text to the lines 40 and 50 on both sides of the substrate and the contrast. Therefore, Hardwick teaches the concept of using opacifying ink in images on both sides of a substrate to alter the viewing exactly as Applicant claims, dependent upon the degree of obscurity desired (lines visible in transmitted but not when observed in reflected light).

Therefore, the combination of technologies of using lines in various ways with opacifying inks would result in the same effects of Applicant. Thus, it would have been obvious to one having ordinary skill in the art to have modified the lines and image of Fan to recognize the black ink performs as claimed or to have included opacifying ink to perform as claimed because Hardwick teaches the concept of altering the way images are seen differently on each side of a substrate as another benefit of protection from

counterfeiting as cited above. The language of the combination thus addresses the limitations of the instant claims. Claims 1-3, 5-7, 11-12, 15-16, and 22-27 are met.

**Claims 1-3, 5-7, 11-12, 15-16, and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,991,260 to Fan et al. in view of US 6,471,248 B2 to Hardwick et al. and further in view of US 6,357,800 B1 to Muller et al.**

Fan and Hardwick teaches the claimed invention above.

The combination doesn't explicitly state the 3D effect results from variable line density or as claimed per claim 2.

Muller teaches optical variable lines to aid against counterfeiting resulting in a moiré pattern (because claim 2 explicitly states that the 3D effect results from variable number density per unit area, and Muller teaches this concept, while it doesn't explicitly state it is a 3D effect, it contains the same description and therefore is equivalent in meaning). See col. 5 and Figs. 2-6 and associated text, and Abstract.

It would have been obvious to one having ordinary skill in the art to have modified the lines and image of the combination to use variable optical line density as claimed because Muller teaches the concept of altering the way images are seen on a substrate as another benefit of protection from counterfeiting as cited above.

**Claims 1-3, 5-7, 11-12, 15-16, and 22-27 are rejected under 35 U.S.C. 103(a) as obvious over US 6,991,260 to Fan et al. in view of US 6,471,248 B2 to Hardwick et al.,**

**and further in view of US 6,357,800 B1 to Muller et al. as evidenced by CA2335239A1 to Zeiter et al.**

The combination does not explicitly state the pattern of lines is a "3D effect".

However, Zeiter teaches a security (page 6, lines 30-31) (counterfeit-proof, equivalent to against copying) having on both sides of a transparent material 10, superimposed, overlapping, and identical images 12 and 14, of patterns of lines (inherently comprised of dots, because individual dots in a line produce lines), in a spatial relationship (because said lines are the same spaced on both sides, they are in series and complementary), changing also in viewing angle, using a mathematical equation (page .6, lines5-32, and page 7, 10-32, FIG. 1 and associated text) resulting in a three dimensional moiré effect, observed in reflected light.

It would have been obvious to one having ordinary skill in the art to have modified the teaching of the combination to include or use or recognize a three dimensional indicia because Zeiter teaches a moiré pattern is three dimensional and teaches a similar security produces the same optical effect as an aid to prevent counterfeiting as cited above.

**Claims 12 and 16 are rejected under 35 U.S.C. 103(a) as obvious over US 6,991,260 to Fan et al. in view of US 6,471,248 B2 to Hardwick et al., and further in view of US 6,357,800 B1 to Muller et al. as evidenced by CA2335239A1 to Zeiter et al. and in view of US 5,449,200 to Andric.**

The combination teaches the claimed invention above. The combination doesn't explicitly state regions of "reduced opacity" as claimed.

However, Andric, analogously directed, shows this feature. Herein the teachings of Andric: Regions 40, 42, 44, 46, 48 (Fig. 1) are transparent (thus including a region of reduced opacity as per instant claim 12). Also Fig. 2 teaches a similar paper, including any pigments to increase opacity. The images are printed using transparent, non-transparent, fluorescent or magnetic inks (13:1-15, same material as magnetic so the excitation what happens under excitation sources are inherent properties). When using transparent ink, the indicia cannot be observed in reflected light when photocopying (see 9:51+). Opaque ink or non-transparent ink is also used for 18, wherein the indicia are visible in transmitted light (see 9:28-30). Opaque regions are taught to change how indicia are viewed (see 9:20-30, 10:55-68, see further FIG. 1, and 11:29-68) describing opaque regions: 54, 56 and transparent regions: 40, 42, 44, 46, 48).

It would have been obvious to one having ordinary skill in the art to have modified the paper support of Fan (see 3:35-40) and all references combined to include regions of reduced opacity as claimed because Andric teaches such features aid in preventing forgery as cited above.

**Claims 22-27 are rejected under 35 U.S.C. 103(a) as obvious over US 6,991,260 to Fan et al. in view of US 6,471,248 B2 to Hardwick et al., and further in view of US**

**6,357,800 B1 to Muller et al. as evidenced by CA2335239A1 to Zeiter et al and in view of US 5,449,200 to Andric.**

The combination essentially teaches the claimed invention above.

The combination doesn't explicitly teach properties as claims 22-27 recite.

Andric teaches inks including phosphorescent, magnetic, or fluorescent inks wherein the indicia are excited under ultra violet light (see 9:40-68; 10:1-30) to change the viewing and adding further security features of the indicia.

It would have been obvious to one having ordinary skill in the art to have modified the combination to include the variety of properties because Andric teaches such inks that inherently have said properties are well known for adding additional security features as cited above.

#### *Response to Arguments*

Applicant's arguments of 12/16/09 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues the Terminal Disclaimer is being submitted, however, the Office has not received it yet and thus the rejection is maintained.

Applicant's arguments toward Andric have been addressed above and indeed teach the various well known security features using lines, inks, and combinations of line patterns. Zeiter is reintroduced again to explicitly show that moiré patterns are indeed three dimensional as explicitly taught. Further see that the 3D effect is also present

when only in planar arrangement as expressed in claim 1 (the use of Fan and Muller indeed teaches this as cited above). Applicant's volume, relief, and 3D effect are thus taught by the combination of art presented above, no matter if the 3D effect is provided by the planar arrangement of lines as expressed in claim 1, or if the 3D effect is as expressed in claim 2. Applicant's attention is directed to the presumed inherent line features to create a 3D effect: it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." *In re Swinehart et al.*, 169 USPQ 226 at 229. Since the Fan, Muller, and Hardwick references teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. Recitation of a newly disclosed property does not distinguish over a reference disclosure of the article or composition claims.

*General Electric v. Jewe Incandescent Lamp Co.*, 67 USPQ 155. *Titanium Metal Corp. v. Banner*, 227 USPQ 773. Applicant bears responsibility for proving that reference composition does not possess the characteristics recited in the claims. *In re Fitzgerald*, 205 USPQ 597, *In re Best*, 195 USPQ 430.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. DICUS whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Ruthkosky can be reached on 571-272-1291. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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